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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,211	06/06/2000	Francis R. Koperda	191910-1061	9999
5642	7590	11/16/2004		
SCIENTIFIC-ATLANTA, INC. INTELLECTUAL PROPERTY DEPARTMENT 5030 SUGARLOAF PARKWAY LAWRENCEVILLE, GA 30044			EXAMINER CARDONE, JASON D	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/588,211

Applicant(s)

KOPERDA ET AL.

Examiner

Jason D Cardone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19,20,22,23 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19,20,22,23 and 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) <sup>6</sup>
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to the remarks of the applicant, filed on 8/16/04, with the RCE. Claims 19, 20, 22, 23 and 26-28 are presented for further examination.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 19 is objected to and rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses collecting data of the total amount of data transmitted from the device upstream and the bite error rate. The specification does not disclose monitoring amount of data "transferred across said link" or amount of "data lost" permitting a flexible billing structure. The specification only collects amount of data going to a server (upstream communication) not the data coming down from a server (downstream). The amount of data transferred across the link would be the total of upstream and downstream data. The specification, also, does not state "transferred across". The specification does disclose collecting bit error rate and "amount of data rejected because they were in excess of requested bandwidth". Neither the bit error rate nor the excess data rejected

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would be disclosed as amount of data lost permitting a flexible billing structure. The specification, also, does not go into detail of how the BER permits a flexible billing structure. Therefore, claim 19 is rejected under 35 U.S.C. 112, first paragraph.

### ***Priority***

4. Applicant's claim for priority as a continuation-in-part under 35 U.S.C. 120 is acknowledged. However, the prior applications (USPN 5,790,806 and 5,966,163) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claim 19 of this application. Both patents do not disclose "transferred across said link" or amount of "data lost" permitting a flexible billing structure. As an example, both patents only collect data upstream from a device to a server but not downstream. The specifications of the patents do not disclose any recording of amount of data transferred across a link from a server to the device (downstream). Therefore, this instant application is not entitled to the benefit of the earlier filing dates of the CIP patents.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 19, 20, 22, 23 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowcutt et al. ("Bowcutt"), U.S. Patent No. 6,308,328.

7. Regarding claim 19, Bowcutt discloses a method of providing statistics for billing users of data services provided over a cable television network comprising the steps of:

monitoring session duration of a link to a network access device and storing data related thereto [Bowcutt, col. 3, lines 2-28, col. 9, lines 17-65 and col. 19, line 63 – col. 20, line 3];

monitoring amount of data transferred across said link and storing data related thereto [Bowcutt, col. 3, lines 6-28 and col. 19, lines 5-15]; and

monitoring amount of data lost in the link and storing data related thereto, the statistics permitting a flexible billing structure [Bowcutt, col. 3, lines 44-55 and col. 19, lines 33-52].

8. Regarding claim 20, Bowcutt further discloses the step of monitoring and storing the start time of the session [Bowcutt, col.9, lines 17-65 and col. 19, line 63 – col. 20, line 3].

9. Regarding claim 22, Bowcutt further discloses the steps of recording the address of the network access device and of apparatus to which the network access device is linked during the session [Bowcutt, col. 6, lines 36-49].

10. Regarding claim 23, Bowcutt further discloses the step of providing a plurality of service tiers depending on maximum shared bandwidth or bit rate [Bowcutt, col. 2, lines 31-45 and col. 9, lines 17-65].

11. Regarding claim 26, Bowcutt further discloses the step of storing preauthorized level of service data for subscribers, an administration computer communicating the preauthorized level of service data to a link access controller for regulating service at the preauthorized level [Bowcutt, col. 8, lines 11-25].

12. Regarding claims 27 and 28, Bowcutt further discloses the step of receiving parametric statistical data for a session of a network access device at an administration computer, wherein the parametric statistical data comprises amount of data transferred and amount of data lost [Bowcutt, col. 3, lines 44-55 and col. 19, lines 5-52].

13. Claims 19, 20, 22, 23 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Liebowitz et al. ("Liebowitz"), U.S. Patent No. 5,812,545.

14. Regarding claim 19, Liebowitz discloses a method of providing statistics for billing users of data services provided over a cable television network comprising the steps of:

monitoring session duration of a link to a network access device and storing data related thereto [Liebowitz, col. 17, lines 34-43 and col. 19, lines 40-50];

monitoring amount of data transferred across said link and storing data related thereto [Liebowitz, col. 18, lines 14-24 and col. 19, lines 40-67]; and

monitoring amount of data lost in the link and storing data related thereto, the statistics permitting a flexible billing structure [Liebowitz, col. 4, lines 30-50, col. 8, lines 25-33 and col. 17, lines 44-57].

15. Regarding claim 20, Liebowitz further discloses the step of monitoring and storing the start time of the session [Liebowitz, col. 19, lines 40-50].

16. Regarding claim 22, Liebowitz further discloses the steps of recording the address of the network access device and of apparatus to which the network access device is linked during the session [Liebowitz, col. 19, lines 40-50].

17. Regarding claim 23, Liebowitz further discloses the step of providing a plurality of service tiers depending on maximum shared bandwidth or bit rate [Liebowitz, col. 19, lines 14-67].

18. Regarding claim 26, Liebowitz further discloses the step of storing preauthorized level of service data for subscribers, an administration computer communicating the preauthorized level of service data to a link access controller for regulating service at the preauthorized level [Liebowitz, col. 18, lines 33-58 and col. 19, lines 14-67].

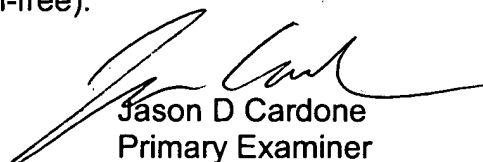
19. Regarding claims 27 and 28, Liebowitz further discloses the step of receiving parametric statistical data for a session of a network access device at an administration computer, wherein the parametric statistical data comprises amount of data transferred and amount of data lost [Liebowitz, col. 18, lines 14-58 and col. 19, lines 14-67].

### ***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (703) 305-8484. The examiner can normally be reached on Mon.-Thu. (9AM-6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jason D Cardone  
Primary Examiner  
Art Unit 2145

November 12, 2004